

REMARKS

Upon entry of this amendment, Claims 1-13, 21 and 25-29 will be pending in the present application. Claims 14-20, 22-24 and 30-45 were previously cancelled. Claim 1 has been amended without prejudice and Applicants' reserve their right to pursue the deleted subject matter in one or more future applications. No new matter has been added.

Claims are not obvious

The Office has maintained its rejection of claims 1, 3, 6-9, 11-13, 21, 25-27, and 29, under 35 U.S.C. §103(a) for allegedly being unpatentable over Butlin et al. (WO 1999/62506) in view of Patani et al. (*Chemical Reviews*, 1996, 3147-3176) ("the combined references"). Applicants traverse and respectfully request reconsideration of the rejection.

The Office asserts that the claimed invention is *prima facie* obvious over the combined references because allegedly Butlin et al. teaches the compound described as Example 393 and Patani et al. teaches that methyl and hydroxyl are bioisosteres, and thus, one ordinarily skilled in the art would have been motivated to modify the halo-hydroxy-C₁₋₆-alkyl at namely, R³, of Example 393 to a halo-C₁₋₆-alkyl with a reasonable expectation of success so as to achieve the compounds of the present invention. See pages 3-5 of the Office Action.

However, the combined references do not the present invention *prima facie* obvious. For example, without conceding to the correctness of the Office's position and to merely advance prosecution, claim 1 has been amended wherein R³ cannot be halo-C₁₋₆-alkyl. Consequently, one ordinarily skilled in the art would have been motivated to modify the halo-hydroxy-C₁₋₆-alkyl at namely, R³, of Example 393, to achieve a compound of amended claim 1. Accordingly, the present invention is not obvious and thus, patentable.

Because of the foregoing, the Office's objection to claims 4, 5, 10 and 28, for being dependent upon a rejected base claim, is moot.

Early reconsideration and allowance is respectfully requested.

The Commissioner is hereby authorized to charge any requisite fee(s) or overpayment to deposit account no. **503201**. The Office is invited to contact the undersigned if an interview would facilitate allowance of the claims.

Respectfully submitted,

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